

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 8, 15 and 23-30 are all of the claims presently pending in the Application. Claim 23 has been amended to more particularly define the invention. Attached hereto is a marked-up version of the changes made to the specification and claims by the current Amendment.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability.

Claims 8, 15, and 23-27 and 29-30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yang (U.S. 6,159,822). Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Brewer (U. S. Patent 6,322,600). Applicant respectfully traverses these rejections based on the attached Declaration and further as discussed below.

The Examiner objects to claim 15 as reciting “predetermined” and, therefore, allegedly reading on a nebulous mental step conducted prior to the manipulative steps of the claimed process. Applicant notes that claim 15 does not recite “predetermined” as alleged by the Examiner. Instead, the Examiner is likely referring to claim 23 which previously recited the term “predetermined”. However, Applicant notes that claim 23 has been amended to delete the recitation by this Amendment.

With respect to the prior art rejections, Applicant first submits that the present invention, on the merits, is not anticipated by Yang under 35 U.S.C. §102(e) nor made obvious by Yang in view of Brewer under 35 U.S.C. §103(a).

Secondly, as indicated by the attached Declaration (which was filed in Application No. 09/326,925 (now U. S. Patent No. 6,270,353 B1), the parent case to the present Application) and its various exhibits, the claimed invention was reduced to practice prior to Yang's U. S. filing date of June 2, 1999. Thus, Yang is not proper prior art against the claims of the present invention and Yang must be removed as a reference, thereby rendering moot both of the prior art rejections.

Alternatively, also as indicated by the attached Declaration and its various exhibits, Applicant earlier conceived the invention and acted with due diligence to reduce the invention to practice from just before June 2, 1999 to June 7, 1999, the U.S. filing date of the present Application. Thus, alternative grounds are provided for removing Yang as a prior art against the claims of the present invention.

Therefore, Yang may not be used as a reference against the claimed invention under any paragraph of 35 U.S.C. § 102, let alone § 102(e). In addition, Yang may not be combined with Brewer to reject the claimed invention under 35 U.S.C. § 103 (a). It is noted that the Examiner relies on Brewer merely to show filling a trench with a particular dielectric.

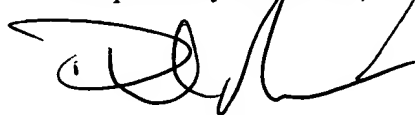
Therefore, it is clear that the present Application has an earlier date of invention than Yang. Therefore, the Examiner is respectfully requested to withdraw these rejections and pass the above case to issue.

In view of the foregoing, Applicant submits that claims 8, 15 and 23-30, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-0481.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims were amended as follows:

23. (Twice Amended) A semiconductor substrate having a planarized structure formed according to a method comprising:

forming a pad on a surface of said substrate;

forming at least one trench in said substrate;

applying a filler material by high density plasma method in said at least one trench and on said pad, said filler material filling at least a portion of said at least one trench [to a predetermined height];

selectively removing said filler material on said pad so as to separate said filler material in said at least one trench and said filler material on said surface by an exposed area of said pad, and

removing said filler material on said pad while allowing said filler material in said at least a portion of said at least one trench to remain [filled to said predetermined height].